Remarks

General

Claims 1-17 and 19-31 are pending in the application. The issues in the application are as follows:

- Claims 1-17 and 19-31 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,948,040 to DeLorme et al. (hereafter, "DeLorme").

In response, Applicants herby traverse the outstanding rejections and request reconsideration and withdrawal in light of the amendments and remarks contained herein.

Rejection of Claims under 35 U.S.C. § 102

Claims 1-17 and 19-31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by DeLorme.

As a starting point, the PTO and the Federal Circuit provide that §102 anticipation requires that <u>each and every element</u> of the claimed invention be disclosed in a single prior art reference. (*In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990)). The corollary of this rule is that the absence from a cited §102 reference of <u>any</u> claimed element negates the anticipation. (*Kloster Speedsteel AB, et al v. Crucible, Inc., et al*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986)). Furthermore, "[a]nticipation requires that <u>all</u> of the elements and limitations of the claims are found within a single prior art reference." (*Scripps Clinic and Research Found. v Genetech. Inc.,* 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991 (Emphasis added)). Moreover, the PTO and the Federal Circuit provide that §102 anticipation requires that there must be <u>no difference</u> between the claimed invention and the reference disclosure. (*Scripps Clinic and Research Found. v. Genetech, Inc.,* id. (Emphasis added)).

Accordingly, if the Applicants can demonstrate that any one element or limitation in claims 1-17 and 19-31 is not disclosed by DeLorme, then the respective claim(s) are not anticipated.

Claims 1 stands rejected under 35 U.S.C. § 102 as being anticipated by DeLorme. Claim 1 has been amended, and now recites in part:

> a printer communicatively coupled to said at least one processor unit to print the contact information to a tag and to print at least the encoded portion of said traveler information on said tag in said machine-readable format, _wherein said tag is configured to be coupled to a user item_. (Emphasis added).

No new matter has been added by the amendment of claim 1. Support for the amendment can be found at least at page 4 line 15 to page 5 line 2, page 6 lines 20-28, and page 8 lines 1-7.

As amended, claim 1 clearly recites at least one element not disclosed in DeLorme, as _DeLorme does not disclose a printer which prints a traveler's contact information on a tag configured to be coupled to a user item_. To support an assertion of anticipation, the Examiner refers to Fig. 3 of DeLorme, contending that Fig. 3 discloses such an "identity tag" (see Office action page 3). However, Fig. 3 of DeLorme does not disclose or suggest a tag as described in Applicants' claim 1. Instead, Fig. 3 presents a drawing showing a preferred data structure for storage retrieval and processing of travel information (_i.e._, a structure for the software management of travel data) (see DeLorme column 30 lines 60-65 and Fig. 3).

Fig. 3 of DeLorme does not show an "identity tag" as contended by the Examiner. Further, even if the data structure show in Fig. 3 of DeLorme was an "identity tag", as contended by the Examiner, such would not disclose printing at least the encoded portion of the traveler information on such a tag in machine readable format, as is described in Applicants' claim 1. Still further, as DeLorme does not disclose such a tag, it cannot disclose or suggest that such a tag be configured to be coupled to a user item, as recited in amended claim 1.

Accordingly, because DeLorme does not disclose each and every element of amended claim 1, claim 1 cannot be anticipated by DeLorme. Therefore, Applicants respectfully request that the rejection be withdrawn, and that claim 1 be allowed in the Examiner's next action.

It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable, and therefore the Applicants do not believe it is necessary to present arguments in favor of each and every claim depending from claim 1. Here claims 2-12 depend from claim 1, and are therefore allowable for at least the reasons discussed above regarding claim 1, as well as for their own recited features which are neither shown nor supported by the cited art. Nevertheless, some features of dependent claims 2-12 are discussed in more detail below.

For example, claim 8 recites in part that, "...said traveler information further includes a travel itinerary for said traveler and <u>wherein said travel itinerary is printed on said tag</u>." (Emphasis added). As discussed above with reference to claim 1, DeLorme does not disclose a tag as required by Applicants' claim 8. Therefore, claim 8 cannot be anticipated by DeLorme.

Claim 13 also stands rejected under 35 U.S.C. § 102 as being anticipated by DeLorme. The Applicants believe that claim 13 is allowable as previously presented, and request reconsideration and allowance in light of the arguments below.

First, with respect to claim 13, DeLorme does not disclose or suggest a means for outputting at least the encoded portion of the user information to a tag which is configured to be coupled to a user item, as is described in claim 13. As was argued above with reference to claim 1, DeLorme does not disclose or suggest a tag as required by Applicants' claim 13. Therefore, DeLorme cannot disclose or suggest outputting encoded information onto such a tag. In addition, DeLorme does not disclose or suggest a means for outputting encoded user information to such a tag in

a machine-readable format, wherein the encoded information includes the user's contact information, as is described in Applicants' claim 13.

Accordingly, because DeLorme does not disclose each and every element of amended claim 13, claim 13 cannot be anticipated by DeLorme. Therefore, Applicants respectfully request that the rejection be withdrawn, and that claim 13 be allowed in the Examiner's next action.

Once again, it is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Here claims 14-17 depend from claim 13, and is therefore allowable for at least the reasons discussed above regarding claim 13, as well as for their own recited features which are neither shown nor supported by the cited art.

Claims 19 stands rejected under 35 U.S.C. § 102 as being anticipated by DeLorme. Claim 19 has been amended, and now recites in part:

> receiving input from said traveler specifying said traveler information including contact information for said traveler; <u>encoding at least said contact information</u> of said received traveler information into a machine-readable format; <u>outputting at least the encoded contact information to a tag in said machine-readable format</u>; and <u>coupling said tag to baggage belonging to said traveler</u>. (Emphasis added).

No new matter has been added by the amendment to claim 19. Support for the amendment can be found at least at page 4 line 15 to page 5 line 2, page 6 lines 6-28, and page 9 lines 11-19.

As amended, claim 19 clearly recites at least one element not disclosed in DeLorme, as <u>DeLorme does not disclose encoding a traveler's contact information, and then outputting at least the encoded contact information on a tag (in machine-readable format)</u> as provided in claim 19. As argued above with reference to claim 1, DeLorme does not disclose or suggest the tag as required by in Applicants' claim 19. <u>Moreover, as DeLorme does not disclose a tag as required by Applicants' claim</u>

19, DeLorme cannot disclose coupling such a tag to baggage belonging to the traveler as required by claim 19.

Accordingly, because DeLorme does not disclose each and every element of amended claim 19, claim 19 cannot be anticipated by DeLorme. Therefore, Applicants respectfully request that the rejection be withdrawn, and that claim 19 be allowed in the Examiner's next action.

It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable, and therefore the Applicants do not believe it is necessary to present arguments in favor of each and every claim depending from claim 19. Here claims 20 and 21 depend from claim 19, and are therefore allowable for at least the reasons discussed above regarding claim 19, as well as for their own recited features which are neither shown nor supported by the cited art. Nevertheless, some features of these dependent claims are discussed in more detail below.

For example, claim 21 recites in part that, "...after the step of outputting at least the encoded contact information to said tag is completed, the method includes attaching said tag to said traveler's baggage before said baggage is relinquished to baggage handling personnel." As discussed above with reference to claim 1, DeLorme does not disclose a tag as required by Applicants' claim 21. In addition, there is no disclosure in DeLorme regarding encoding contact information on such a tag, and there is also no disclosure regarding attaching such a tag to the traveler's baggage before the baggage is relinquished as provided in claim 21. Therefore, claim 21 cannot be anticipated by DeLorme.

Claim 22 also stands rejected under 35 U.S.C. § 102 as being anticipated by DeLorme. The Applicants believe that claim 22 is allowable as previously presented, and request reconsideration and allowance in light of the arguments below.

First, as described above with reference to claim 1, DeLorme does not disclose or suggest a baggage tag as is required by Applicants' claim 22. Secondly, because DeLorme does not disclose such a tag, DeLorme cannot disclose printing at least the encoded portion of the traveler information <u>on such a baggage tag</u> in machine-readable format as required by claim 22. Similarly, DeLorme does not disclose or suggest a printer communicatively coupled to the processing unit <u>to print contact information to a baggage tag</u> as required by Applicants' claim 22.

Accordingly, because DeLorme does not disclose each and every element of amended claim 22, claim 22 cannot be anticipated by DeLorme. Therefore, Applicants respectfully request that the rejection be withdrawn, and that claim 22 be allowed in the Examiner's next action.

Once again, it is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Here claims 23-31 depend from claim 22, and are therefore allowable for at least the reasons discussed above regarding claim 22, as well as for their own recited features which are neither shown nor supported by the cited art.

Summary
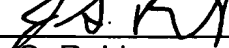
The Applicants believe that this response constitutes a full and complete response to the Office action, and therefore request timely allowance of claims 1-17 and 19-31 as argued above.

The Examiner is respectfully requested to contact the below-signed representative if the Examiner believes this will facilitate prosecution toward allowance of the claims.

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

Respectfully submitted,

Trisha S. Kruse and David J. Luman

Date: January 24, 2004

By _____

John S. Reid
Attorney an agent for Applicants
Reg. No. 36,369
Phone: (509) 534-5789